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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,352	12/11/2003	Jukka Salonen	0365-0638PUS1	3575
2292 7590 08/05/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER SALLARD, SHANNON S				
ART UNIT 3628		PAPER NUMBER		
NOTIFICATION DATE 08/05/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/734,352

**Applicant(s)**

SALONEN, JUKKA

**Examiner**

SHANNON S. SALIARD

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 and 24-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-893)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II (claims 19-23) in the reply filed on 08 May 2008 is acknowledged.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. **It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.**(emphasis added). In this case the Abstract begins with "The invention relates to". Appropriate correction is required.

### ***Claim Objections***

3. **Claim 1** is objected to because of the following informalities: The acronym "SMS" is recited in the claim limitation. It is suggested that the applicant use the official name on the first reference, so that the meaning will be clear. If the applicant intends to use the acronym later in the in the claims, let readers know this by setting it off in parentheses directly after the first reference. Appropriate correction is required. Further, the limitation "authenticating the client if a reply to the SMS message is received at the

unique reply address" appears to be a conditional statement. When using a conditional statement, it appears that the claim should also make provisions if a reply to the SMS message is not received. Appropriate correction is required.

4. **Claim 22** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The test as to whether a claim is a proper dependent claim is that it shall include every limitation of a claim from which it depends (35 U.S.C. 112, fourth paragraph), or in other words, it shall not conceivably be infringed by anything which would not also infringe the basic claim (The Infringement Test, see MPEP 608.01 (n)III). In this case, claim 22 does not pass the infringement test.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claim 22** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per **claim 22**, the claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 22, written in independent form, is in "single means claim" format since it recites only one element to do all the functions recited. The claim is not written in "means-plus-function" language, however, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993, the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language). Claim 22 is drawn to any "server", regardless of construct, that performs the function recited. This parallels the fact situation in *Fiers* wherein "a DNA" recited. This CAFC stated in *Fiers* at 1606 "Claiming all DNA's that achieve a result without defining what means will do so in not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived". See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatAppInt) 17 USPQ2d 1545, 1547 (1/30/1989) where the claims at issue were rejected for being analogous to single means claims even though "means" was not literally used. Thus, claim 22 yields a "server" that achieves a result without defining what will do so.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 19, 21, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarnanen [US 6,085,100] in view of Kagi [US 2002/0028686].

As per **claim 19**, Tarnanen discloses a) assigning a unique reply address to an SMS message from a multiplicity of available reply addresses [col 2, lines 34-37, and col 7, lines 21-41];

b) sending the SMS message to the client at the client identifier address [Fig. 5, step 40]; and

c) replying to the SMS message at the unique reply address [Fig. 6, step 50].

Tarnanen does not disclose authenticating the client if a reply to the SMS message is received at the unique reply address. However, Kagi discloses authenticating a client if a reply to the SMS message is received at a reply address [0029]. It would have been obvious to one of ordinary skill in the art to include in the SMS communication system of Tarnanen the ability to authenticate the client as taught by Kagi since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 21**, Tarnanen further discloses wherein the method further includes storing the reply in a matrix including a first axis indexed by client calling line identifier number and a second axis indexed by reply address [col 6, lines 19-57; Fig. 4].

As per **claim 23**, Tarnanen further discloses wherein the client's identifier address includes an identifier chosen from the group consisting of a client's A-subscriber's number, Calling Line Identity, e-mail address and IP address [col 6, lines 27-30].

9. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tarnanen [US 6,085,100] in view of Kagi [US 2002/0028686] as applied to claim 19 above, and further in view of Brown et al [US 2002/0080822].

As per **claim 20**, Tarnanen does not disclose wherein the unique reply address is assigned at random from among the multiplicity of available reply addresses. However, Brown et al discloses assigning addresses randomly [0037]. It would have been obvious to one of ordinary skill in the art at the time of the invention to have assigned an address at random as in the improvement discussed in Brown et al in the system executing the method of Tarnanen. As in Brown et al, it is well within the capabilities of one of ordinary skill in the art to install associated software to Tarnanen's mobile computer communicating with the gateway with the predicted result of securely identifying messages as needed in Tarnanen.

10. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Tarnanen [US 6,085,100] in view of Kagi [US 2002/0028686] as applied to claim 19 above, and further in view of Fok [US 2002/0165000].

As per **claim 22**, Tarnanen does not disclose wherein the mediator includes a network server programmed to perform the method. However, Fok discloses a mediator with a server for communicating and translating SMS messages between parties [0025]. It would have been obvious to one of ordinary skill in the art to include in the SMS communication system of Tarnanen a mediator that includes a server as taught Fok since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.



***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fostick [US 2002/0173319] discloses assigning a unique identifier to a SMS conference group.

Wills [US 2002/0191795] discloses a proxy gateway that uses an identifier of a mobile device and a cryptographic key to determine whether the request is valid.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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